IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Brett T. Hannigan

Application No.: 09/543,125

Filed: April 5, 2000

For: INTERNET-LINKING SCANNER

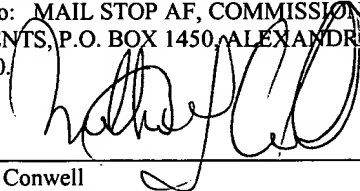Examiner: D. Hess

Date: March 14, 2006

Response Under 37 CFR § 1.116
Expedited Procedure

Art Unit 2876

Conf. No. 7024

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on March 14, 2006, as First Class Mail in an envelope addressed to: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

William Y. Conwell
Attorney for Appellant

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant requests review of the appealed-from rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than five attached pages are provided.)
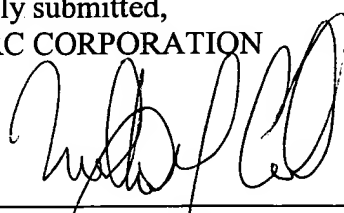
Date: March 14, 2006

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Respectfully submitted,
DIGIMARC CORPORATION

By_____
William Y. Conwell
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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Board will reverse the rejections. A few reasons for reversal are noted below.

Claim 3 is rejected under § 103 over Jepson preambles in view of Kurowski (6,553,127). In a previous Action (11/18/03), however, the present Examiner found Claim 3 allowable over such art.[1] The Examiner stated:

> *The rejection of claim 3 is withdrawn, as the applicant's arguments are convincing. Indeed, the examiner could not find motivation in the prior art of record for using motion sensors for another purpose, particularly since a separate data-gathering sensor is already present.[2]*

Appellant respectfully submits that the Examiner was correct in his earlier statement. There is no motivation in the art for using motion sensors for another purpose – particularly since a separate data-gathering sensor (i.e., the linear sensor array) is already present.

Claim 33 is modeled after claim 3, and its rejection will be similarly reversed.

Claims 4-7, 10, and 13-20 are also rejected based on Jepson preambles in view of Kurowski.

Claim 4 introduces a limitation not found in Kurowski. The Final Action does not address how or why Kurowski suggests "beginning a watermark detection process *before data from the linear sensor array is finally processed*." Obviousness has not been established.

Claim 5 also introduces a limitation not found in Kurowski. The Action does not address how or why Kurowski suggests "beginning to sense *a watermark calibration signal*." Obviousness has not been established.

Likewise, claim 6 is not taught or suggested by Kurowski. His teaching of testing blocks to see if they pass a preselection process does not suggest the specified arrangement, in which data from *the 2D sensors* is used to identify promising portions.

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[1] The Jepson preambles and Kurowski were applied in the rejection of other claims in that Action.
[2] Emphasis added.

Claim 7 also defines an arrangement not taught by Kurowski. The "texture criterion" employed by Kurowski does not refer to a physical texture. Rather, it indicates the relative busyness of the pixelated image data, *i.e.*, whether it is flat and featureless, or whether it has a lot of spectral energy:

> *For example, the block selector 120 may evaluate a "texture" criterion for each block and output a texture value where 0 (zero) indicates a completely flat, featureless and relatively unchanging field within a block and where higher numbers indicate increasing spectral content.*

Claim 7, in contrast, requires quantifying an object's "surface characteristic." Kurowski has no teaching on this point. He does not concern himself with physical media, but rather just digital data.

The rejections of claims 10, 13, and 19, like claim 3, are based on substitution of hindsight for any teaching in the art. Certainly, Kurowski requires a data stream to operate upon. However, this fact - alone - cannot be the sole predicate for obviousness, for so doing would render obvious *all* arrangements for acquiring such a data stream. That logic proves too much. There is nothing in the cited art, and no rationale offered in the Action, motivating an artisan to adopt the particular arrangements defined by these claims. Rather, it appears the unseen hand of hindsight is at work.

Regarding claim 14, the Office has disregarded limitations in the claim when it states that "A 'calibration' signal could be anything used to mark an area where a watermark might be." Claim 14 requires that the specified "calibration signal" be one <u>that allows information about the scale or rotation of the watermark data to be determined</u>. Scale and rotation are not addressed in Kurowski.

Claim 16 requires that the <u>technique</u> employed to decode the watermark information <u>be determined at least in part by said attribute information</u>. Kurowski does not teach this. The "selected characteristics" to which Kurowski refers helps identify portions of the data

stream from which a watermark might be successfully decoded. This answers the question "where to decode" – not "what decoding technique to employ." Kurowski has no teaching on the latter point.

Regarding claim 20, Kurowski is silent concerning sampling rates. The inference stated in the Final Action is not a teaching found in the art. Again, hindsight is evident.

Claims 21 and 23 stand rejected over Katoh, alone.

Katoh discloses a barcode scanner (e.g., for a supermarket) that emits scanning beams out two windows.

Katoh's use of two scanning windows is not to achieve any advantageous binocular-based effect, as specified by appellant's claims. Rather, Katoh scans out two windows in order to be more forgiving in placement of the articles being scanned ("The object of the present invention is to easily read bar codes without being affected by the position at which they are attached to an object that is to be read...".[3]).

Moreover, Katoh indicates that only a single window is used at a time. Scanning out both windows simultaneously is taught *against* by Katoh to avoid undesired interference ("Two sets of laser beam sources are alternatingly turned on after each time T, and the reflected light is detected by the light-receiving elements to read the bar codes, *while eliminating the noise (interference) caused by the other scanning beam*".[4]).

And again, claim 21 requires "a visual output device," and specifies that the scanner memory includes "program instructions causing the CPU to control the visual output device, at least in part, in accordance with information decoded from the scan data." Again, the cited art is silent on such a feature, and fails to teach or suggest why an artisan would adopt the claimed methodology in a scanner of the detailed design.

Likewise, the rejection of dependent claim 23 is similarly deficient, as being based on hindsight reconstruction rather than a teaching or suggestion from the art.

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[3]   Katoh, col. 2, lines 31-33.
[4]   Katoh, col. 6, lines 9-14.

For brevity's sake, the foregoing discussion has reviewed just certain of the claims pending in the application, and only selected points have been reviewed in connection with each. Many other points that might have been raised concerning the claims, the art, and the rejections, have not been belabored.

Nonetheless, the foregoing brief observations are believed sufficient to establish that the outstanding rejections would not be sustained by the Board.